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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/622,057 | 07/16/2003 | Steven Jonathan Spinner | 035334-006 | 2279 |

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EXAMINER

MOSSER, KATHLEEN MICHELE

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3715

DATE MAILED: 12/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|--------------------------------|--|
| Office Action Summary | Application No. 10/622,057 | Applicant(s) SPINNER ET AL. | |
| | Examiner Kathleen Mosser | Art Unit 3715 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16-25 is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-13 is/are rejected.
- 7) ☒ Claim(s) 14 and 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

In response to the amendment filed 09/26/2005, claim 8 has been cancelled; claims 1-7 and 9-25 are pending.

Drawings

1. The drawings were received on 09/26/05. These drawings are accepted as formal and overcome the previous objections.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 6 and 7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Although the specification as originally filed include a mention of psychological test it fails to teach how such tests are implemented in the current invention. Unlike the specific details given about the use of physical and physiological tests and the clear understanding of how such relates to the identification of a physical activity compatible with the user, there is no mention of how psychological test can be used to make the same determination or in what manner they are implemented into the current system and method.

3. Claims 6 and 7 are further rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant's amendment to

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the claims dated 09/26/2005 introduced the limitation "a plurality of psychological tests indicating data representative of the person's perception towards the different physical activities". Applicant relies upon paragraph 54 for support of the amendment. The paragraph reads, in part: "In accordance with one embodiment of the present invention, the psychological tests may include personal preferences and interests tests. The psychological tests may be designed to measure the concentration level, confidence level, control skills, commitment level, leadership skills, adaptability skills, and socialization skills". The rest of the paragraph goes on to mention several possible tests. This paragraph does not mention that the tests measure the "person's perception" towards the different physical activities. It is unclear how any of the tests mentioned are capable of performing such an analysis. Perceptions are a mental image or concept about something. This is clearly different from an interest or preference questionnaire as described in this section of the specification.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-7 and 9-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In order for a method to be statutory it must produce a useful, concrete and tangible result. In the present case the method fails to produce a tangible result. Something is tangible if it is substantially real, or capable of being precisely identified or realized by the mind (*Merriam-Webster's Collegiate Dictionary, Tenth Edition*). The present method results in the step of "identifying at least one specific physical ability most compatible with the person based" on a comparison. The act of identifying is synonymous with an act of determining. Neither of these acts is "real" or capable of being precisely identified or realized (i.e. tangible), unless the identification or determination is shown or otherwise communicated. Claims 2-7 and 9-13 fail to correct this deficiency and are rejected for the same

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reasons. Claim 14 introduces the step of displaying and thus introduces a real and perceivable outcome to the method and is thus not rejected under this statute.

Response to Arguments

5. The previous rejections under 35 USC §112, second paragraph are withdrawn in view of the amendments to the claims.

6. The examiner previously took official notice that: (1) wobble board tests, hand speed coordination test, grip strength test, vertical jump test, standing long jump test, sit and reach test, foot speed coordination test, pull-ups test, abdominal strength tests, 25-meter sprint test, one-turn agility run tests, and cardiovascular endurance tests are old and well-known physical activity tests in the art of physical fitness and personal training; and (2) that resting heart rate tests, standing height test, skinfold tests, body composition test, bone diameter tests, muscle girth tests, and limb and length tests are old and well known in the art of physical fitness. As the applicant has failed to challenge these finding, and in accordance with MPEP §2144.03 these facts are now considered admitted prior art.

7. Applicant's arguments filed 09/26/2005 have been fully considered but they are not persuasive.

Arguments under 35 USC §112 first paragraph

This issue is fully addressed in the now amended rejection of the claims above.

Arguments concerning Zarif and Reitman

Applicant asserts that neither Zarif nor Reitman teaches the features of "identifying at least one specific physical activity most compatible with the individual based" on the comparison and "comparing the results of the plurality of tests with a database, said database including the results of said plurality of tests subjected to a set of athletes from a different physical activities". In support of this argument applicant attempts to define the term "compatible" by pointing to paragraph 15 of the specification, which recites:

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FIG. 1 illustrates a block diagram of a system 100 for testing and evaluating a person's athletic ability in accordance with one embodiment of the present invention. A person 102 is subjected to several tests at a testing location 104. The tests may include but are not limited to physical, physiological, and psychological tests. Examples of the type of tests are described in more details below in FIG 5. The testing location 104 may also comprise a client 106 coupled to a printer 108. The client 106 may include a computing system and a display, such as a monitor (not shown). The results of the tests of the person 102 are entered on the client 106 and submitted through the internet 110 to a server or computer system 112 located at an analysis location 114. The server 112 is described in more detailed in FIG. 3. The server 112 analyses and compares the data received from the client 106 with a database (not shown) coupled to server 112. The database contains the results of the same tests subjected on a set of athletes from different sports, sports positions, disciplines, and physical activities. The analysis determines which physical activity the person 102 has more aptitude for based on the results of his/her tests at the testing location. The analysis is described in more details below in FIG. 4.

This paragraph describes using the comparison to determine and "aptitude" and makes no direct correlation between the two terms. Absent an explicit definition in the specification the claim language must be given a plain meaning. Compatible or compatibility is defined as: capable of existing together in harmony (*Merriam-Webster's Collegiate Dictionary, Tenth Edition*). Whereas aptitude is defined as: an inclination, tendency or a natural ability or talent. The words are not synonymous with one another.

In the Zarif invention the system uses the results of a plurality of tests and questionnaires to determine which physical activities are most likely to allow the user to achieve the results, see for example paragraphs 35 and 36. In this manner the system is determine which activities are most compatible with the objectives of the users.

Regarding the arguments concerning Reitman, the arguments are persuasive and thus the previous rejections under 35 USC §103(a) have been withdrawn.

Allowable Subject Matter

8. Claim 16-25 are allowed.
9. Claims 14 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

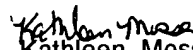
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10. This action is made non-final in view of the new grounds of rejection under 35 USC §101.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen Mosser whose telephone number is (571) 272-4435. The examiner can normally be reached on M-F 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on (571) 272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Kathleen Mosser
Patent Examiner
Art Unit 3715

December 8, 2005